

REMARKS

Claims 21 to 23, 25, 28, 30, 31 and 33 are canceled without prejudice, and therefore claims 20, 24, 26, 27, 29, 32 and 34 to 36 are pending and now being considered.

Applicants respectfully request reconsideration of the present application in view of this response.

As to the comments on the previously filed IDS, all of the Japanese language documents (1) Kenichi Sato, Satoru Okamoto, "Evolution of path layer techniques toward photonic networks", (IEICE conference, SB-7-1, September 1992), (2) Kenichi Sato, Hiromu Toba, "Trends of photonic Transport Network technologies" (IEICE, Vol. 80, No. 9, pp. 947-959, September, 1997), and (3) Satoru Okamoto, "Network node interface structure for WDM optical path transport networks," (IEICE, Society conference, B-10-98, September, 1997) are specifically described in the specification, and this therefore satisfies any requirement to provide a concise explanation of the reference and its relevance.

Still further, it is respectfully submitted that documents (1) and (2) discuss a general optical communication network technology in which a connection is established by using an optical path, and document (3) discusses details on an OTM signal and a format of the optical path signal, as is further described in the specification.

It is therefore respectfully requested that these references of the previously filed IDS be considered and made of record.

As to the objections to the specification as to the claimed subject matter and as to the related indefiniteness rejections under the second paragraph of U.S.C. 112, it is respectfully submitted that the claims as now presented herein plainly obviate any issues raised in the Office Action. Also, claims 21 to 23, 25, 28, 30, 31 and 33 are canceled without prejudice. It is therefore respectfully requested that the objections and related indefiniteness rejections.

With respect to paragraph eight (8) of the Office Action, claims 22, 24 and 36 were rejected under 35 U.S.C. § 102(b) as anticipated by Ueda et al., U.S. Patent No. 5,359,600.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim limitations be identically described, an anticipatory reference

must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine must fail absent the foregoing conditions.

While the anticipation rejections may not be agreed with, including in view of the foregoing, to facilitate matters, claim 22 has been canceled without prejudice as explained above.

As to Ueda, it only indicates that each multiplex signal is decomposed into signals of lower digital hierarchical levels, and that a number of incoming STM signals of lower levels are multiplexed into a higher level STM signal format (col. 2, lines 38-46). Romeijn discloses that no VC-4 patch overhead is generated (col. 2, line 62).

The Ueda reference, however, does not identically disclose (nor suggest) the claim features which provide for a “*buffering process for the packets to convert the packets (arriving at irregular intervals) into a plurality of data streams*”, for a “*buffering process for the data of the SDH section payload to generate data streams*”, and for “[*extracting*] the packets from the data streams by using at least one data link process”, as provided for in the context of the claimed subject matter of claim 24, as presented.

Accordingly, claim 24, as presented, is allowable, as is its dependent claim 26.

Claim 36, as presented, includes features analogous to those of claim 24, as presented, and is therefore allowable for essentially the same reasons.

As regards paragraph eleven (11), claims 19, 21, 25, 27, 30, 32 and 35 were rejected under 35 U.S.C. § 103(a) as unpatentable over the “Ueda” reference in view of Romeijn, U.S. Patent No. 5,457,691.

As to obviousness, in rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As further regards the obviousness rejections, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim element and there must be a motivation or suggestion for combining the elements in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998). The references relied upon simply do not address the problems (referred to in the present application) that are met by the subject matter of any of the rejected claims.

While the rejections may not be agreed with, including in view of the foregoing, to facilitate matters, claims 21, 25, and 30 are canceled without prejudice as explained above.

As to Ueda, it only indicates that each multiplex signal is decomposed into signals of lower digital hierarchical levels, and that a number of incoming STM signals of lower levels are multiplexed into a higher level STM signal format (col. 2, lines 38-46). As to the secondary Romeijin reference, it only indicates that no VC-4 patch overhead is generated (col. 2, line 62).

As to claim 19, as presented, Ueda does not disclose nor suggest the claim features of a “unit configured to perform a buffering process for the packets to convert the packets (arriving at irregular intervals) into a plurality of data streams”, or a “unit configured to map the data streams into an SDH section payload without adding any overhead for upper layer transmission”, so that claim 19 is allowable, as is its dependent claim 20.

Claim 27, as presented, includes features like those of claim 19, as presented, and is therefore allowable for essentially the same reasons, as is its dependent claim 29. As further regards claim 27, the applied references do not disclose nor suggest the claim feature of performing a “buffering process for the data of the SDH section payload to generate data streams” and for “extract[ing] the packets from the data streams by using at least one data link layer process”. Accordingly, claim 27 is allowable for these further reasons.

Claim 32, as presented, includes features like those of claims 19 and 27, as presented, and is therefore allowable for essentially the same reasons, as is its dependent claim 34.

Claim 35, as presented, includes features like those of claim 19, as presented, and is therefore allowable for essentially the same reasons.

As regards paragraph fifteen (15), claim 20 was rejected under 35 U.S.C. § 103(a) as unpatentable over the “Ueda” reference in view of Romeijn, U.S. Patent No. 5,457,691 as applied to claim 19, and further in view of Vogel, U.S. Patent No. 6,075,788 and the Simpson document (May 1994).

Claim 20 depends from claim 19 and is therefore allowable for the same reasons, since the tertiary references do not cure – and are not asserted to cure – the critical deficiencies of the primary and secondary references.

As regards paragraph seventeen (17), claims 23, 26 and 31 were rejected under 35 U.S.C. § 103(a) as unpatentable over the “Ueda” reference, as applied to claims 22, 25 and 30, and further in view of Vogel, U.S. Patent No. 6,075,788 and the Simpson document (May 1994).

While the rejections may not be agreed with, including in view of the foregoing, to facilitate matters, claims 23 and 31 are canceled without prejudice as explained above.

Claim 26 depends from claim 24, as presented, and is therefore allowable for the same reasons, since the secondary references do not cure – and are not asserted to cure – the critical deficiencies of the primary reference.

In summary, it is respectfully submitted that all of claims 20, 24, 26, 27, 29, 32 and 34 to 36 of the present application are allowable at least for the foregoing reasons.

CONCLUSION

In view of the foregoing, it is believed that the objections and rejections have been obviated, and that claims 20, 24, 26, 27, 29, 32 and 34 to 36 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, and that the present application issue as early as possible.

Respectfully submitted,

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